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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/633,216      | 08/07/2000  | Robert E. Heinemann  | 5140-01             | 4031             |

7590 07/13/2004

Paulding & Huber LLP  
City Place II  
185 Asylum Street  
Hartford, CT 06103-3402

EXAMINER

LE, DAVID Q

ART UNIT PAPER NUMBER

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/633,216

Applicant(s)

HEINEMANN ET AL.

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all passages in the cited references as potentially teaching all or part of the claimed inventions.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2004 has been entered.

### ***Status of Claims***

3. Per the Request for Continued Examination and Preliminary Amendment filed April 19, 2004:  
Claims 5 and 18 were cancelled.  
Claims 1 and 14-16 were amended.  
Claims 1-4, 6-11 and 13-17 remain pending.

### ***Response to Remarks***

4. Applicant's remarks with respect to the new amendments made to the claims have been considered but are not persuasive and fail to overcome the references Crooks, Landry and Brown.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-4, 6-11 and 13-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Crooks et al.** in view of **Landry**, and further in view of **Brown**, US Patents No. 5,943,656, 5,956,700, and 5,875,435 respectively.

As per **claims 1, 15 and 16.**

All three references disclose:

A [computerized method/system/storage medium] of generating payment for electronic billing data (Crooks: Abstract, Summary of the Invention, Fig 1-5, associated text; Landry: Abstract; Summary of the Invention; Fig 1-6; associated text; Brown: Abstract; Summary of the Invention; Fig 1-4, associated text; Fig 4: Box 300: "Instruction to Transfer Funds?"; Boxes 302-303: "Debit Account #1", "Credit Account #2", associated text; Col 7, lines 24-41), comprising the steps of:

automatically obtaining billing data in an electronic format from a billing party for a billable party (Crooks: Fig 3-4, associated text; Landry: Fig 11: Processing "Payee EDI File", associated text; Brown: Fig 1: Box 40: "Enter Updates from Subsidiary Automated Ledgers"; Fig 2: Box 112: Record All Transactions by Account to Ledger File(s)"; associated text; Col 3, Line 65 – Col 4, line 35);

automatically comparing said billing data with rule data defined by said billable party (Crooks: Fig 5: "check against tolerance parameters", associated text; Landry: Fig 12A: "child-payee payment parameters are met"; associated text; Brown: Fig 1: Boxes 52-64: "Is Entry Valid?"; "Is Instruction Valid?"; Fig 2: Boxes 130-152; associated text; Col 5, Line 64 – Col 6, line 8).

Crooks does not specifically recite

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said billing data including billing codes which identify the specific tasks undertaken by the billing party as a part of the services rendered; and

automatically authorizing generation of payment data if said billing data satisfies said comparison with said rule data.

Landry's system pays bills "without requiring interaction with the payors" (Landry: Abstract, Summary of the Invention; Fig 3, associated text), but is silent on the use of billing codes as recited by Applicant.

However, Brown discloses using transaction (i.e. billing) codes which identify the specific tasks undertaken by a billing party as a part of the services rendered (Brown: Fig 1: Box 22; Fig 2: Box 102; associated text; Col 2, lines 26-27, 32-34, 41-55; Col 3, lines 43-48, 54-64; Col 4, lines 20-35; Col 5, lines 9-15); and

automatically authorizing generation of payment data if said billing data satisfies said comparison with said rule data (Brown: Fig 1, 4; associated text; Col 7, lines 23-41: "...automatic (electronic) transfer of funds/payments..") .

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the features taught by Crooks, Landry, and Brown to provide a bill payment system that would be able to handle all possible bill paying situations, therefore making the system more useful and attractive to users. This system would meet the limitation of claims 1, 15, 16, as analyzed above.

None of the references specifically recite "formatting billing data" in order to automatically process billing information input by payees and to generate payment for services rendered. However, it is well known in the art that data input into server systems for processing need to be provided in specific formats in order for said data to be parsed successfully and properly manipulated. All three references in fact do teach that such data will need to be provided in specific formats, in order to be useful (Crooks: Abstract; Figs 5, 10-12: "Invoice #, Amount"; associated text; Brown: C2, L26-37: "standardized codes, provided before, during, and after the time of the transactions..."; Landry: Fig 4-5: "EDI Form Processing"; associated text). Therefore it is obvious that the new limitations amended to these claims would be inherent in the methods taught by the references, both singly and in combination, and as a result, are not patentable over the prior art.

As per claim 2.

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Crooks and Brown further disclose

... rule data are comparison statements stored in a rules database (Crooks: Fig 5: "tolerance parameters"; associated text; Brown: Fig 1-2, associated text; Col 5, line 65 - Col 6, line 8).

As per claim 3.

Crooks and Brown further disclose

... payment data includes financial data for input to an accounting system of the billable party (Crooks: C4, L34; C6, L17-36; Brown: Fig 1-4, associated text; Fig 4: Box 300: "Instruction to Transfer Funds?"; Boxes 302-303: "Debit Account #1", "Credit Account #2", associated text; Col 7, lines 24-41).

As per claim 4.

Crooks and Brown further disclose

...payment data includes electronic funds transfer (EFT) data (Crooks: C6, L17-36; C10, L5-19; Brown: Col 7, line 24-41).

As per claim 6.

Crooks further discloses

... generating payment data for said authorized billing data; and providing said payment data to said billable party for generating payment to said billing party (Crooks: C5, L1-12; Fig 5: "render payment", associated text). Crooks' system does not disclose an automatic payment feature.

However, Landry's system can pay bills "without requiring interaction with the payors" (Landry: Abstract, Summary of the Invention, Fig 3, associated text).

Brown's system also allows automatic bill payment (Brown: Fig 1, 4; associated text; Col 7, lines 23-41: "...automatic (electronic) transfer of funds/payments..") .

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined Crooks' authorization feature with Landry's and Brown's automatic payment feature to provide a system that would be able to handle all possible bill paying situations, therefore making the system more useful and attractive to users.

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As per claim 7.

All three references further disclose

... generating a summary message specifying a billing data total amount to be paid (Crooks: Fig 3, associated text; C6, L1-16; Landry: Fig 19C, associated text; Brown: Fig 4: Box 312: "Instruction to Transfer Data"; Box 322: "Instruction to Adjust Current Records"; associated text); and

automatically electronically notifying said billing party of said summary message (Crooks: Abstract, C3, L41-54; Landry: Fig 19F-H, associated text; Brown: Fig 4: Box 312: "Instruction to Transfer Data"; Box 322: "Instruction to Adjust Current Records"; associated text).

As per claim 8.

None of the references specifically recite:

... generating billing data analysis reports for review by said billable party utilizing said billing data wherein said billing data includes corporate billing codes which identify the specific tasks undertaken by the billing party as a part of the services rendered.

However Brown (see citations from claim 1) teaches that transaction codes representing standardized as well as custom budget categories would be used in a preferred embodiment of his invention. Such categories and subcategories would serve to accurately report specific products and services being billed for, and would make the accounting/bill payment system more flexible and useful to its owner/users. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to include this feature in a bill payment system modeled after Crooks, Larry, and Brown, to make the system more adaptable to customization by users, thus making the system more useful and attractive to those users.

As per claim 9.

Landry and Brown further disclose

... billing data analysis reports are for review by said billing party (Landry: Fig 19G, 25A-B, associated text; Brown: Fig 3: Box 240: "Transmit Ordered Reports"; associated text; Col 6, line 43-59).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to make analysis reports available for review to billing parties, so that these parties may determine the status of their invoices, make corrections, or obtain summaries of their activities. Such a capability would make the system more attractive to billing parties, in addition to billable parties.

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As per claim 10.

Crooks and Brown further disclose

...providing interactive computer screens so that said billable party supplies analysis data for inclusion in billing data analysis reports (Crooks: Fig 8-12, associated text; C10, L28 – C12, L6; Brown: see above citations; Col 3, line 26-39).

As per claim 11.

Neither reference specifically discloses

... analysis data includes case budget data including total case time, case hours, case costs, hourly rate, and case difficulty.

However, Crooks teaches that many different and customizable parameters and variables may be used in order to analyze billable data (Crooks Fig 8-12, associated text; C10, L28 – C12, L6; C5, L44-67). And Brown teaches that varying degrees of categorizing may be done to provide the rules for accepting billable data from vendors (Fig 1-2, associated text; see citations from claim 1 above). Such variables constitute what Applicant defines as "case budget data". Therefore claim 11 is clearly unpatentable over Crooks in view of Landry and Brown.

As per claims 13 and 17.

Crooks in view of Landry and Brown meet all the limitations of claims 1 and 16.

Landry further discloses that any invoice processed by his system will result in a "mailer" advising the billing party of the resolution of the invoice (Landry: Fig 12A, 20, 25A-B, associated text). Both Landry and Crooks teach that communications may be effected via the Internet (see Abstracts, Summaries of both references).

Brown also teaches that his system would be best implemented over a network of computers (Col 3, line 15-25) and that messages may be provided as feedback for each transaction input into the system, to advise a user whether the system has accepted or rejected the input (Fig 1-4, associated text; Fig 1-2: "Print Error Statement", transmission steps 61, 141; associated text). Therefore, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that a system as envisioned herein should comprise the further

...step of automatically electronically notifying said billing party if said billing data does not satisfy



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said comparison with said rule data, said billing and rule data ... by billing party.

This further step would allow billing parties to always be aware of whether their invoices had been accepted by the system or not, so that they would be able to correct and resubmit them if certain invoices had been rejected. This instant notification process would go a long way toward making prospective users of the system more attracted to adopting it.

As per claim 14.

Crooks in view of Landry and Brown disclose

A computerized method for automatically processing an electronic invoice generated by a billing party for a billable party utilizing rule data defined by said billable party and an invoice processing party (see citations from all three references used for claims 1, 15-17 above), said method comprising the steps of:

electronically submitting an electronic invoice to an invoice processing party (Crooks: C9, L59 – C10, L18; Landry: Fig 3: "TCF and/or TCF Interface Bank"; associated text; Brown: Fig 1-2, associated text; see all above citations) for automatic evaluation in accord with rule data defined by a billable party and said invoice processing party, said rule data including billing codes... services rendered;

automatically evaluating said electronic invoice in accord with said rule data (Crooks: Fig 5: "Audit Process; Landry: Fig 12A-E, associated text; Brown: Fig 1-2, associated text; see all above citations);

automatically electronically notifying said billing party of results of said evaluation (see citations, obviousness analysis for claims 7, 13 above);

automatically generating payment data for an electronic payment and designating said electronic invoice as paid, if said electronic invoice satisfies said evaluation (Crooks: Fig 5, "render payment"; Brown: Fig 1-2, associated text; see all above citations); and

automatically generating invoice analysis reports for said billable party utilizing said paid electronic invoice (Crooks: C11, L10-12, Fig 7, associated text; Landry: Fig 24A-B, associated text; Brown: Fig 1-3, associated text; see all above citations).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the features of the three referenced systems in order to provide a full-service, automatic invoice processing method, because such a method would be more attractive to users wishing to have both an automatic service as well as one where they would be able to authorize individual invoices, as long as those invoices met certain previously set rule data. The system would also be attractive to billing parties, because it provides them with full service as well, and quick, accurate reports on their billing activities.

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Also, none of the references specifically recite "formatting billing data" in order to automatically process billing information input by payees and to generate payment for services rendered. However, it is well known in the art that data input into server systems for processing need to be provided in specific formats in order for said data to be parsed successfully and properly manipulated. All three references in fact do teach that such data will need to be provided in specific formats, in order to be useful (Crooks: Abstract; Figs 5, 10-12: "Invoice #, Amount"; associated text; Brown: C2, L26-37: "standardized codes, provided before, during, and after the time of the transactions..."; Landry: Fig 4-5: "EDI Form Processing"; associated text). Therefore it is obvious that these new limitations would be inherent in the methods taught by the references, both singly and in combination, and as a result, are not patentable over the prior art.

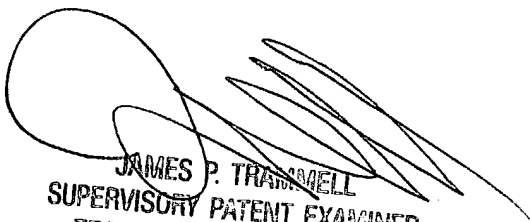
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DQL



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2300